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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,597	12/12/2001	Robert Paul Cazier	10014023-1	3325

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EXAMINER

DOAN, DUYEN MY

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/021,597	Applicant(s) CAZIER ET AL.	
	Examiner Duyen M. Doan	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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**DETAIL ACTION**

Claims 1-19, 20-21 are amended.

Claim 18 is cancelled.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (pat num 6839741) in view of Funk et al (us pat 5937162) (hereinafter Funk).

**As regarding claim 1**, Tsai disclosed a computer network (figure 1, network 16); a server communicating over said computer network and including an undelivered data storage (figure 1, server 20); and a sender computer communicating over said computer network (figure 1, sender 12); and wherein said e-mail system posts at least a portion of said previous e-mail message to said undelivered data storage in said server (col.1, lines 55-65) and sends a notification e-mail message to the intended recipient notifying the intended recipient of the existence of the previous e-mail message, wherein the notification e-mail message includes instructing said intended recipient as to how to retrieve said least a portion of said previous e-mail message (col.3, line 1-34).

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Tsai did not expressly disclose electronic mail system examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous email message, and wherein, automatically in response to determining that said previous e-mail message was not received by the intended recipient.

Funk taught electronic mail system examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous email message (see Funk col.11, lines 1-13, col.15, lines 4-29), and wherein, automatically in response to determining that said previous e-mail message was not received by the intended recipient (see Funk col.3, lines 38-40)

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the system Tsai with the teaching of Funk to examines a received e-mail message to determine whether a previous e-mail message was not received by an intended recipient of the previous email message, and wherein, automatically in response to determining that said previous e-mail message was not received by the intended recipient for the purpose of tracking the email messages through the system before it is transmitted and if the message bounces when it returns to the system (see Funk col.9, lines 44-48).

**As regarding claim 2,** Tsai-Funk disclosed computer network further comprises a plurality of inter-connected computer networks (see Tsai figure 1).

**As regarding claim 3,** Tsai-Funk disclosed notification e-mail includes a server retrieval address comprising a hypertext markup language (HTML) address link

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identifying the location of said least a portion of said previous e-mail message in said undelivered data storage (see Tsai col.3, line 1-34).

**As regarding claim 4**, Tsai-Funk disclosed notification e-mail includes a server retrieval address comprising a uniform resource locator (URL) address identifying the location of said least a portion of said previous e-mail message in said undelivered data storage (see Tsai col.4, line 11-26).

**As regarding claim 5**, Tsai disclosed sender computer further comprising: a sent message storage storing previously sent e-mail messages (see figure 1, sender computer 12); a received message storage storing received e-mail messages (see figure 1, sender computer 12); a server retrieval address storage storing a server retrieval address of at least a portion of a sent e-mail message posted to said server (see figure 1, sender computer 12); posts said at least a portion of said previously sent e-mail message to said server, and sends said notification e-mail message to said intended recipient (col.3, line 1-24).

Tsai did not expressly disclose a comparison rule that governs how a bounce is detected; wherein said sender computer compares a previously sent message was bounce to said previously sent e-mail messages according to said comparison rule, determines whether said received message was bounced.

Funk taught a comparison rule that governs how a bounce is detected (see Funk col.9, lines 44-48, col.11, lines 1-13, col.15, lines 4-29), wherein said sender computer compares a previously sent message was bounce to said previously sent e-mail messages according to said comparison rule, determines whether said received

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message was bounced(see Funk col.9, lines 44-48, col.11, lines 1-13, col.15, lines 4-29). The same motivation was utilized in claim 1 applied equally well to claim 5.

**As regarding claim 6**, Tsai-Funk disclosed sender computer receives a server retrieval address from said server after said at least a portion of said previously sent e-mail message is posted to said server, with said server retrieval address being included in said notification e-mail message (see Tsai col.6, lines 58-67 to col.7, lines 1-5).

**As regarding claim 7**, Tsai-Funk disclosed server further comprising: a sent message storage storing previously sent e-mail messages (see Tsai figure 1, server 20, with storage 22, also see Funk col.15, lines 4-29); a received message storage storing received e-mail messages (see Tsai, figure 1, server 20, with storage 22, also see Funk col.15, lines 4-29); sends said notification e-mail message to said intended recipient (see Tsai, col.4, line 11-26).

Tsai did not expressly disclose a comparison rule that governs how a bounce is detected; wherein said server compares a received message to said previously sent messages according to said comparison rule, determines whether one of said previously sent message was bounced.

Funk taught a comparison rule that governs how a bounce is detected; wherein said server compares a received message to said previously sent messages according to said comparison rule, determines whether one of said previously sent message was bounced (see Funk col.9, lines 44-48, col.11, lines 1-13, col.15, lines 4-29). The same motivation was utilized in claim 1, applied equally well to claim 7.

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**As regarding claim 8**, Tsai-Funk disclosed server transmits a server retrieval address to said intended recipient after a message bounce is detected, with said server retrieval address being included in said notification e-mail message (see Tsai col.4, line 11-26).

Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai (pat num 6839741) and Funk et al (us pat 5937162) (hereinafter Funk) further in view of Collins et al (us 2002/0013817) (hereinafter Collins).

**As regarding claim 9**, Tsai disclosed sending a first e-mail message to an intended recipient, wherein the first e-mail message includes one or more attachment (col.3, lines 45-54), posting at least a portion of said first e-mail message to a server accessible to the intended recipient automatically(col.1, lines 55-65, col.3, line 1-24); and automatically notifying said intended recipient of an availability of said at least a portion of said bounced e-mail message on said server; wherein said intended recipient accesses said server in response to successfully performing said posting step, in order to obtain said at least a portion of said bounced e-mail message (col.1, lines 55-65, col.3, line 1-24).

Tsai did not expressly disclose receiving a second e-mail message after sending the first e-mail message; determining if the size of the first e-mail message exceed a size limit, wherein the determination is based, at least in part, on information included in the second e-mail message, in response to a determining that the size of the first e-mail message exceed the size limit.

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Funk taught receiving a second e-mail message after sending the first e-mail message, wherein the determination is based, at least in part, on information included in the second e-mail message (see Funk Col.9, lines 44-48, col.11, lines 1-29, col.15, lines 1-29).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the system Tsai with the teaching of Funk to have receiving a second e-mail message after sending the first e-mail message, wherein the determination is based, at least in part, on information included in the second e-mail message for the purpose of tracking the email messages through the system before it is transmitted and if the message bounces when it returns to the system (see Funk col.9, lines 44-48).

The combination of Tsai and Funk did not disclose determining if the size of the first e-mail message exceed a size limit, and determining that the size of the first e-mail message exceed the size limit.

Collins taught determining if the size of the first e-mail message exceed a size limit, and determining that the size of the first e-mail message exceed the size limit (see Collins, pg.2, paragraph 14).

It is obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Tsai-Funk with the teaching of Collins to have determining if the size of the first e-mail message exceed a size limit, and determining that the size of the first e-mail message exceed the size limit, for the purpose of determining if recipient are unable to receive the attachment and take further action based on the determination (see Collins pg.2, paragraph 14).

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**As regarding claim 10**, Tsai-Funk-Collins disclosed server performs the determining and notifying steps (see Tsai col.3, line 1-24).

**As regarding claim 11**, Tsai-Funk-Collins disclosed at least a portion of said first e-mail message consists of said one or more attachments (col.3, lines 1-34).

**As regarding claim 12**, Tsai-Funk-Collins disclosed sender computer performs the determining and notifying steps (see Tsai figure 1, sender communicate with recipient through non internet email 18).

**As regarding claim 13**, Tsai-Funk-Collins disclosed sending a notification e-mail message to said intended recipient (see Tsai col.3, line 18-24).

**As regarding claim 14**, Tsai-Funk-Collins disclosed the notifying step further comprising embedding an HTML address link in a notification e-mail message (see Tsai col.3, line 25-33).

**As regarding claim 15**, Tsai-Funk-Collins disclosed the notifying step further comprising embedding a URL address in a notification e-mail message (see Tsai col.4, line 11-26).

**As regarding claim 16**, Tsai-Funk-Collins disclosed embedding a unique identifier in each outgoing e-mail message (see Funk col.9, lines 44-48, col.11, lines 1-13, col.15, lines 4-29) comparing a previously sent message unique identifier to a received message unique identifier (see Funk col.9, lines 44-48, col.11, lines 1-13, col.15, lines 4-29) determining the previously sent message was bounced if a match is found (see Funk col.9, lines 44-48, col.11, lines 1-13, col.15, lines 4-29). The same motivation was utilized in claim 9 applied equally well to claim 16.

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**As regarding claim 17**, Tsai-Funk-Collins disclosed comparing at least a portion of said first e-mail message to a portion of said second email message; and determining that said first message was bounced if said portions match (see Funk col.9, lines 44-48, col.11, lines 1-13, col.15, lines 4-29). The same motivation was utilized in claim 9 applied equally well to claim 17.

**As regarding claim 19**, the limitations are similar to claim 17, therefore rejected for the same rationale as claim 17.

**As regarding claim 20**, the limitations are similar to claim 9, therefore rejected for the same rationale as claim 9.

**As regarding claim 21**, Tsai-Funk-Collins disclosed the second e-mail message includes a hyperlink to the file (see Tsai col.4, lines 16-22).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-17, 19-21 have been considered but are moot in view of the new ground(s) of rejection.

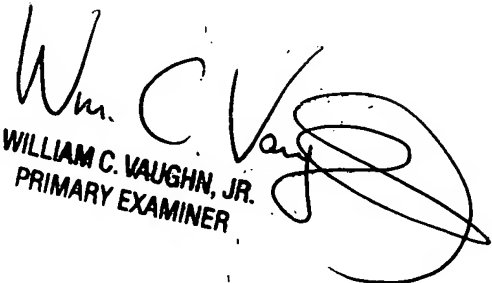
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 571 272 3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner  
Duyen Doan  
Art unit 2143

  
WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER